REMARKS

Amendments to the Specification

The specification has been amended to correct typographical errors. Applicant respectfully submits that these amendments find support in the specification as originally filed and, therefore, do not constitute new matter.

Claim Rejections – 35 U.S.C. §102

Claims 1-17 stand rejected under 35 U.S.C. §102(b) as being anticipated by Shane (U.S. Patent No. 5,793,972).

Directing Examiner's attention to MPEP 2131, the threshold issue under Section 102 is whether the Examiner has established a *prima facie* case for anticipation. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)". "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1989).

Claim 1 recites a messaging system comprising a messaging engine for operating under user instructions to generate and transmit messages addressed to recipient contacts, wherein the system comprises a server comprising "a client interface (4) comprising means for allowing access by a plurality of users of registered clients; a client manager (2) comprising means for maintaining a database of registered clients; a content

manager (25) comprising means for receiving content items uploaded from users and for storing said content in a content database ....".

Shane does not disclose means for allowing access by a plurality of users of registered clients, maintaining a database of registered clients, receiving content items uploaded from users and storing the content in a content database, as recited in Claim 1.

Shane merely teaches generating messages to guide a contact recipient into accessing web pages. There is no discussion at all of a platform for registered clients to upload content to be sent to recipient contacts. Although Examiner refers to reference numeral 12 as a client manager comprising means for maintaining a database of registered clients, reference numeral 12 is merely a *recipient* database. A recipient database is entirely different from the database of registered clients, as the registered client is the one who uploads the content and sends the message, while the recipient contact is the one who receives the message and views the content.

Applicant respectfully submits that Shane fails to teach each and every element of Claim 1 of the present invention. Therefore, Applicant respectfully submits that Claim 1 is currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

Since Claims 2-14 depend from Claim 1, Applicant respectfully submits that they are also patentable as they contain the same limitations as their parent claim.

Furthermore, Claim 4 recites a messaging system "wherein the server further comprises a contacts manager (10) comprising means for managing a contacts database (11) of contacts uploaded by users, in which contacts are associated with the users and with profile attributes."

Shane fails to disclose contacts being associated with users and with profile attributes, as recited in Claim 4. Shane merely describes a web server computer 16 "electronically coupled to recipient database 12 to enable web server computer 16 to retrieve the recipient data for each direct mail recipient." (Col. 4, lines 20-22). There is no mention of users, let alone contacts being associated with users and with profile attributes.

Also, Claim 6 recites a messaging system "wherein the content items comprise content collateral parts and message text uploaded by users." Shane does not disclose collateral parts and message text that is uploaded by users. Shane only teaches recipient mailing lists being entered into a recipient database. As would be appreciated by one having ordinary skill in the art, recipient mailing lists do not constitute collateral parts and message text.

Additionally, Claim 13 recites a messaging system as claimed in claim 1, wherein the messaging engine comprises means for "receiving a message generated by a user locally using an external messaging application; parsing said message and generating a message having a wrapper with links to content of the content database according to the parsing."

Shane does not disclose a messaging engine comprising means for receiving and parsing a message generated by a user locally using an external messaging application, and generating a message having a wrapper with links to content of the content database according to the parsing, as recited in Claim 13.

Examiner cites Col. 5, line 63 to Col. 6, line 11 in asserting that Shane describes means for receiving a message by a user locally using an external messaging application. However, Shane merely discloses an advertiser obtaining mailing lists from list brokers, and the lists being sent to a data house, where direct mailing is created using the lists and

mailed with the post office. *Merriam Webster's Collegiate Dictionary, 10th Edition* provides the following definition:

application *n*   1 : (3): a program (as a word processor or a spreadsheet) that performs one of the important tasks for which a computer is used

As would be appreciated by one having ordinary skill in the art, direct mailing deposited with the post office does not constitute a program, and therefore, cannot be considered to be an external messaging application.

Examiner argues that the Internet can also be considered an external messaging application since it has global reach. However, Shane does not disclose the use of the Internet in the distribution or reception of the data from the mailing lists. Furthermore, in order to anticipate a claim, the claimed subject matter must be disclosed in the reference with sufficient specificity to constitute an anticipation under the statute. MPEP 2131.03. A mere reference to the Internet would not have sufficient specificity to constitute the anticipation of receiving a message by a user locally using an external messaging application.

Examiner cites Col. 5, lines 51-62 in asserting that Shane describes parsing the message and generating a message having a wrapper with links to content of the content database according to the parsing. However, Col. 5, lines 51-62 do not disclose any type of interaction with a message generated by a user using an external messaging application, let alone parsing such a message and generating a message having links to content of a content database according to the parsing. This passage merely describes how the server processes a URL provided by a responding recipient.

Applicant respectfully submits that Claims 2-14 are currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 15 recites a method of, under user instructions, generating a message and sending it to a recipient contact, the method being carried out by a server and comprising the steps of "a user uploading content collateral and message text to the server, and the server storing said collateral and text with profile attributes; the user uploading contact data, and the server storing the contact data with profile attributes; generating a message by matching profile attributes of the contact with those of the content to select content, and including in the message uploaded message text and links to said selected content; transmitting the message to the contact ...."

Shane does not disclose a user uploading content collateral and message text to the server, and the server storing the collateral and text with profile attributes, as recited in Claim 15. Shane merely teaches recipient database 12 storing "recipient data records 22 containing recipient addressing information, such as the recipient's name and address and a unique personal identification code for each intended direct mail recipient." (Col. 3, lines 64-67). Therefore, Shane only discloses the storage of *contact data*, not the uploading and storing of *content collateral* and *message text* along with *profile attributes*.

Shane also fails to disclose generating a message by matching profile attributes of the contact with those of the content to select content, and including in the message uploaded message text and links to said selected content, as recited in Claim 15. Shane merely teaches "printing direct mail pieces 26 displaying thereon the name, address and uniform resource locator containing a unique personal identification code, for each intended recipient." (Col. 4, lines 9-13). There is no discussion of any type of matching

of profile attributes of a contact with the profile attributes of content in order to select content.

Applicant respectfully submits that Shane fails to teach each and every element of Claim 15 of the present invention. Therefore, Applicant respectfully submits that Claim 15 is currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

Since Claims 16 and 17 depend from Claim 15, they are also patentable as they contain the same limitations as their parent claim. Therefore, Applicant respectfully submits that Claims 16 and 17 are currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

If the Examiner has any questions regarding this application, the Examiner may telephone the undersigned at 775-586-9500.

Respectfully submitted,
SIERRA PATENT GROUP, LTD.

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Kenneth D. Alessandro
Reg. No. 29,144

Sierra Patent Group, Ltd.
P.O. Box 6149
Stateline, NV 89449
(775) 586-9500